

## REMARKS

### **I. Status**

In the Office Action dated October 17, 2007, the Examiner: (i) objected to Figure 1A; (ii) rejected to claims 7 and 11 under 35 U.S.C. 112; (iii) rejected claims 1, 11, 12, 21 under 35 U.S.C. 112; (iv) rejected claim 24 under 35 U.S.C. 112; (v) rejected claims 1, 3-10, 12-16, and 19-21 under 35 U.S.C. 103(a) as being unpatentable over US2004/0049729A1 (Penfield) and US2002/0124016A1 (Rank et al.); and (vi) rejected claims 11 and 22-24 under Section 103(a) as unpatentable over Penfield, Rank, and U.S. Publication 2004/0181748 (Jamshidi)

To put the Application in condition for allowance, Applicant has rewritten claim 21 in independent form, and cancelled claims 1-10 and 12-20. Applicant reserves the right to pursue the cancelled claims in a subsequent application.

Applicant has also amended claims 11 and 22 to address the outstanding Section 112 rejections, and amended claim 24 to correct antecedent basis. Applicant does not believe these amendments will affect the scope of the claim.

Claims 11 and 22-24 will be pending after entry of this Amendment.

### **II. Rejections under Sections 112**

The Examiner rejected claim 11 under the written description requirement of Section 112, first paragraph, as lacking support for “replacing the copied list of elements in the temporary structure with the summary information.” Applicant respectfully traverses. Support for this language can be found in the *Abstract* (stating that one embodiment includes “replacing the selected list of numbers with the summary information”); *at pg. 2, lines 19-20* (stating that one embodiment includes “replacing the selected list of numbers with the summary information”); *pg. 6, lines 2-5* (explaining that “[s]ome embodiments may also replace list of elements 129 in the clipboard with a table containing the function name(s) and result(s). These embodiments may be desirable because the statistical information can then be easily “pasted” into another application, such as a word processing program”); *pg. 13, lines 7-8* (claiming “replacing the selected list of elements with the summary information”); and *pg. 14, line 11* (claiming “replacing the selected list of numbers with the summary information.”)

The Examiner also rejected claims 11 and 21 under the written description requirement of Section 112, first paragraph, as lacking support for “automatically converting [sic] the list of elements to a required type for the desired summary function.” Applicant respectfully traverses. Support for this feature can be found at least at *pg. 5, lines 17-21* (explaining that “[t]he operating system 124b then parses the selected text to extract the individual elements of the list 129 at block 206. Part of this process includes looking for blanks, commas, tabs, carriage return commands, or other separators commonly used to separate elements in a list. At block 208, the module 125 will then construct an array containing the elements identified at block 206.”) However, to avoid confusion with the description of block 208 at *pg. 5, lines 22-23*, Applicant has amended claims 11 and 21 to recite “required input.” Applicant believes the new language is also in closer agreement with the additional details in dependent claims 23 and 24.

The Examiner also rejected claim 24 under the written description requirement of Section 112, first paragraph, as lacking support for “removing [the at least one] separator from the list of elements.” Applicant respectfully traverses. Support for this element can be found at *pg. 5, lines 17-21* (explaining that “[t]he operating system 124b then parses the selected text to extract the individual elements of the list 129 at block 206. Part of this process includes looking for blanks, commas, tabs, carriage return commands, or other separators commonly used to separate elements in a list. At block 208, the module 125 will then construct an array containing the elements identified at block 206.”)

The remaining Section 112 rejections are moot in view of the claim cancellations.

## **II. Rejections under Section 102 and 103**

The Examiner rejected claims 11 and 22-24 under Section 103(a) as unpatentable over Penfield, Rank, and U.S. Publication 2004/0181748 (Jamshidi). Applicant notes that the Jamshidi reference was published on September 16, 2004, which is after the filing date (February 12, 2004) of this Application. Accordingly, the Jamshidi reference is only prior art under Section 102(e).

Applicant respectfully submits that the Jamshidi reference is not available to support a rejection under 35 U.S.C. §103(a) because the Jamshidi patent and the present patent application

were commonly owned at the time of the invention by International Business Machines Corporation (IBM). 35 U.S.C. §103(c)

### III. Objections to Drawings

Applicant would like to thank the Examiner for the interview explaining the objections to the drawings. In response, Applicant submits herewith a substitute drawing containing descriptive names of the various elements. Support for these names can be found at pg. 4, lines 3-19 of the Specification.

### IV. Conclusion

In view of the foregoing comments and amendments, the Applicant respectfully submits that all of the pending claims (i.e., claims 11 and 22-24) are in condition for allowance and that the Application should be passed to issue.

Respectfully submitted,

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